

***United States Court of Appeals  
for the Second Circuit***



**APPELLANT'S  
BRIEF**





ORIGINAL  
74-1559 <sup>B</sup>/<sub>P/S</sub>

To be argued by  
WILLIS H. TAYLOR, JR.

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United States Court of Appeals  
FOR THE SECOND CIRCUIT

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VANITY FAIR MILLS INC.,  
*Plaintiff-Appellant,*

*v.*

OLGA COMPANY (INC.),  
*Defendant-Appellee.*

APPEAL FROM THE UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF NEW YORK;

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TO REVIEW DECISION IN A DECLARATORY JUDGMENT  
PATENT ACTION

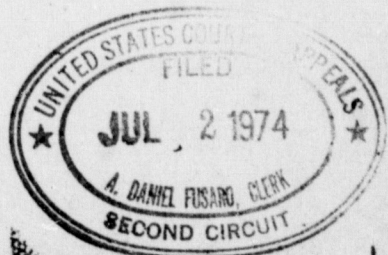
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PLAINTIFF-APPELLANT'S BRIEF

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References to printed Plaintiff's Exhibits are indicated by PX followed by its number followed by App. E followed by the page number thus (PX      , App. E      ).

References to printed Defendant's Exhibits are indicated by DX followed by its number followed by App. E followed by the page number thus (DX      , App. E      ).

Both Plaintiff's and Defendant's garment exhibits are physical and will be indicated by the identifying number thereof preceded by PX or DX.

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PATENT ACTION

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## **PLAINTIFF-APPELLANT'S BRIEF**

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### **I. Statement of the Issues Presented for Review**

The issues presented for review by plaintiff-appellant are:

- (a) Its charge of invalidity of Olga U.S. Patent No. 3,142,301 and claims 1 and 2 thereof, as obvious under 35 U.S.C. 103.
- (b) Its charge of invalidity of Olga U.S. Patent No. 3,142,300 and claims 1 and 3 thereof, as obvious under 35 U.S.C. 103.
- (c) Olga U.S. Patent No. 3,142,301 and claims 1 and 2 thereof, being invalid, cannot be infringed.



- (d) Olga U.S. Patent No. 3,142,300 and its claims 1 and 3 thereof, being invalid, cannot be infringed.
- (e) The declaration of validity of Olga U.S. Patent No. 3,142,301, and claims 1 and 2 thereof by defendant-appellee.
- (f) The declaration of validity of Olga U.S. Patent No. 3,142,300, and claims 1 and 3 thereof by defendant-appellee.
- (g) The declaration of defendant-appellee of infringement of Olga U.S. Patent No. 3,142,301, claims 1 and 2 thereof, by plaintiff-appellant, Vanity Fair Mills Inc.
- (h) The declaration of defendant-appellee of infringement of Olga U.S. Patent No. 3,142,300, claims 1 and 3 thereof, by plaintiff-appellant, Vanity Fair Mills Inc.
- (i) The award to defendant-appellee of damages no less than a reasonable royalty, with interest.
- (j) The issuance of an injunction against plaintiff-appellant, Vanity Fair Mills Inc., prohibiting further infringement of Olga U.S. Patents Nos. 3,142,301 and 3,142,300.

## **II. Statement of the Case**

### **1. Nature Of The Case.**

This is an appeal by plaintiff-appellant in a declaratory judgment patent action. The complaint filed by plaintiff, Vanity Fair Mills Inc. (App. 7a) sought a declaratory judgment holding defendant's, Olga Company (Inc.), patents Nos. 3,142,300 (PX 3, App. E34) and 3,142,301 (PX 1, App. E1) each to be invalid and not infringed by plaintiff.

By counterclaim filed with its answer (App. 12a) defendant Olga sought a judgment that its said patents are valid



and that plaintiff Vanity Fair had infringed each of said patents. Plaintiff's reply (App. 15a) denied validity of the patents and denied infringement thereof. At the trial, defendant relied upon claims 1 and 2 of its patent No. 3,142,301 (PX 1, App. E2) and claims 1 and 3 of its patent No. 3,142,300 (PX 3, App. E35).

Plaintiff-appellant's appeal is from the Judgment (App. 45a) and Amended Judgment (App. 69a) entered by the District Court, Southern District of New York (Hon. Thomas P. Griesa). The Opinion of the District Court dated January 8, 1974 (App. 19a) and its Amended Opinion (App. 50a) constitutes its Findings of Fact and Conclusions of Law holding claims 1 and 2 patent No. 3,142,301 (PX 1, App. E2) and claims 1 and 3 of patent No. 3,142,300 (PX 3, App. E35) each valid and infringed by plaintiff's Vanity Fair brief Style 40-28 (PX 23). The opinion dated January 8, 1974, is reported at 369 F. Supp. 1233.

## **2. The Parties.**

Plaintiff-appellant, Vanity Fair, is a Pennsylvania corporation having a place of business at Reading, Pennsylvania, with an office and place of business at 640 Fifth Avenue, New York, New York, and is engaged in the manufacture, sale or distribution of ladies' undergarments and lingerie.

Defendant-appellee, Olga Company (Inc.), is a California corporation of which the patentee Olga Erteszek of defendant's patents, is an officer and principal garment designer. It has an office and place of business at 45 Park Avenue, New York, New York.

## **3. The Subject Matter Of Defendant's Olga Patents.**

Olga patent No. 3,142,301, the first filed, November 20, 1962 (PX 1, App. E1) is entitled "Elasticized Panty Garment". The second Olga patent No. 3,142,300 filed later

April 29, 1963 (PX 3, App. E35) is entitled "Elasticized Panty Girdle". The second patent represents it is an "improvement" in the type of structure of the first patent.

Both defendant's Olga patents state identically in its introductory paragraph:

"This invention relates to elasticized panties in the category of so-called 'briefs', in that the garment is legless and is adapted to elastically fit about the wearer's legs."

Defendant's Olga patents each define identically the respective garments thereof as the:

"\* \* \* combination of a torso-encircling elastic body portion which serves the purposes of a girdle, and a front panel and crotch portion as associated therewith as to form with independent capacities for movement as later described, an overlying front reinforcement and means in conjunction with the body [the girdle] providing leg openings."

Also each patent represents:

"The panel structure serves the further important function of reinforcing the front area of the girdle for stomach [abdominal] confinement, an effect which is enhanced by the capacity of the crotch section in the worn condition of the garment to tension downwardly the panel area."

Olga Erteszek, the patentee of both defendant's patents, testified at the trial that the "panty girdle" or "brief" was known long prior to the filing dates of the defendant's patents. She explained (App. 256a):

"\* \* \* the panty girdle or brief consisted of a girdle portion, a crotch portion and a panel portion connected to the crotch."

This Court in *Gossard v. Neatform*, 240 F.2d 948 (1957) affirmed the decision of the District Court, 143 F. Supp. 139, and held the Peck patent for "Panty Girdle" (PX 7, App. E73) invalid, saying (p. 949):

"A panty girdle is an apparently well known article of feminine underwear of that type known in the trade as a 'foundation' garment."

The District Court had said (p. 140):

"A panty girdle is, of course, not a novel idea nor is the center front panel of the garment a novel idea, and no claim is made by the plaintiff with respect thereto. It was also admitted that an elastic edging or decoration around the perimeter of each leg opening is not new."

The "Panty Girdle" of the Peck patent (PX 7, App. E73) like the "Panty Girdle" of defendant's Olga patents "is legless and is adapted to elastically fit about the wearer's legs."

The 1954 Gossard advertisements of the Peck patent "panty girdle" emphasized (PX 13, App. E89):

"You need never again hear that old pantie complaint, 'it binds my legs'. Gossard's new pantie is so radically different that *legs can't feel it*. And this pantie really *controls* the figure."

And:

"satin elastic smooths the tummy."

And:

"This is the Gossard that stole the pantie show in Chicago and New York and did it with orders!"

Despite the great commercial success of the Peck "panty girdle", the District Court in the *Neatform* case held (pp. 143-44):

"\* \* \* the subject matter of the design as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the said subject matter pertains."

The District Court also observed (p. 143):

"In fact, it has been said that to invent anything in the way of a new dress design however temporarily attractive such design may be, becomes almost impossible when one considers the enormous amount of fashion advertising design service, magazines and the host of skillful and intelligent dressmakers. *White v. Lombardy*, DCSDNY, 1941, 40 F. Supp. 216. *It may be that it is for reasons similar to this that there has not been a design patent upheld by the Court of Appeals in the Second Circuit subsequent to 1926.*" (Emphasis added.)

The last case decided by this Court involving a garment patent was in 1957 in *Formal Fashions v. Braiman Bows*, wherein the District Court held the patent for "Body Encircling Garments" invalid under 35 U.S.C. 103 (254 F. Supp. 389) and this Court affirmed (369 F.2d 536).

### III. Argument

#### A. The Defendant's Olga Patent No. 3,142,301 And Its Claims 1 And 2 Are For Obvious Subject Matter And Are Invalid Under 35 U.S.C. 103.

The principal question here presented is whether the subject matter disclosed in defendant's Olga patent No.



3,142,301 (PX 1) for "Elasticized Panty Garment" and claimed in claims 1 and 2 thereof, is obvious.

This Court in *Lemelson v. Topper*, 450 F.2d 845 (1971), pointed out (p. 846):

"The standards currently used are that to be patentable an invention must be useful, novel and non-obvious. In *Graham v. John Deere Co.* (383 U.S. 1) the Court set the guidelines to be used in applying the nonobvious standard of section 103:

'Under § 103, the scope and content of the prior art are to be determined; the differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.' "

The Supreme Court in *Graham v. Deere*, 383 U.S. 1, held (p. 33):

"It is of course, well settled that an invention is construed not only in the light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office."

The file wrapper (PX 2, App. E4) containing the prosecution history in the Patent Office of defendant's Olga patent No. 3,142,301 (PX 1) shows that both the Examiner and the applicant Olga recognized that prior Rosenthal patent No. 2,763,008 entitled "Girdle Panty Garter Belt" (PX 5, App. E67) disclosed a garment that differed but slightly in the arrangement of the elements of the combination from that disclosed in the Olga patent.

The original main claim 1 submitted with the Olga patent application as filed claimed (PX 2, App. E12):

1. An elasticized "brief" undergarment comprising
  - (a) a torso encircling body made of elastic fabric,  
and

- (b) a *front panel* of elastic material overlying and having side edges sewn to said body along portions of said edges running from the body waist downwardly to locations above the front bottom edge of the body,
- (c) said side edges of the panel being free below said locations, and
- (d) the panel being progressively narrowed downwardly to a *crotch portion* of the garment connected to the rear of the body,
- (e) the free edges of the panel and crotch portion together with the bottom edge of the body defining *leg openings* the edges of which are adapted to elastically fit the wearer. (Emphasis added.)

Thus, original Olga claim 1 claimed the "combination" as described in the specification of the Olga Patent No. 3,142,301, namely (PX 1, App. E2):

"\* \* \* combination of a torso-encircling elastic body portion which serves the purposes of a girdle, and a front panel and crotch portion so associated therewith as to form with independent capacities for movement as later described an overlying front reinforcement and means in conjunction with the body [the girdle] providing leg openings."

Upon initial examination by the Examiner in the Patent Office, original Olga claim 1 and the five claims dependent thereupon were rejected by the Examiner on prior Rosenthal patent No. 2,763,008 (PX 5, App. E67) the Examiner holding (PX 2, p. 10, App. E16):

"The patent to Rosenthal discloses an undergarment including a *torso encircling body* made of *elastic fabric*, a *front panel* (7) having side edges sewn to the body portion, said side edges of the panel being free

at the lower portion thereof, the free edges of the panel and *crotch portion* together with the bottom edge of the body defining *leg openings*. The inclusion of a *panel member disposed on the girdle body* does not impose a limitation on the claims. Such an expedient is considered to be within the normal skills of the art, as are other dimensional differences that may exist between applicant's panel construction and that of Rosenthal." (Emphasis added.)

The Examiner in his Official Action dated December 10, 1963, in the Olga patent application rejected the Olga claims on the Rosenthal patent disclosure (PX 5) holding that in the Olga combination (PX 2, p. 17, App. E23):

"The inclusion of a front panel \* \* \* overlying the front of the body [girdle] involves merely a simple expedient of choice. This would be an obvious reversal of arrangement. No new nor unobvious result or advantage is seen in disposing the front panel upon the front body portion [girdle]."

Thereupon, it was admitted by applicant Olga in an amendment to the Olga application dated January 30, 1964 (PX 2, p. 19, App. E26):

"As the examiner has indicated in the Official Action of December 10, 1963, one of the principal differences between the applicant's garment and that disclosed in Rosenthal lies in the fact that the applicant's [Olga] panel overlies or is on the outside of the torso encircling body [girdle]." (Emphasis added.)

At the trial, the patentee Olga Erteszek admitted (App. 276a-278a):

"Q. Have you ever constructed a garment as in your patent 3,142,301 (PX 1) with the panel on the inside?  
A. Yes, I have.

"Q. Mrs. Erteszek, the question was, did you ever make a garment like your patented one [PX 1] only instead of having the panel on the outside of the skirt you put it on the inside?

"The Witness: That's what I did.

"Q. That was unsatisfactory, is that what you are saying? A. It was an improvement over what has to be heretofore, but it wasn't fully satisfactory to me, therefore, I tried to improve it.

"Q. And why was it that the panel arranged on the inside in the patent Plaintiff's Exhibit 1 was at least somewhat operative while you contend the Rosenthal patent disclosure Plaintiff Exhibit 5, was completely unsatisfactory? A. Because, as you can see in the design of—

"Q. You are referring to Fig. 2 of Plaintiff's Exhibit 1? A. Fig. 2, yes.

"Q. Go ahead. A. The lower part, the oval as it is in this particular garment, is unattached in the front part underneath so by the wearer's walking for a certain amount of time it would tend to slip up slightly. It would work very well with garters.

"The Court: If the panel were inside?

"The Witness: If the panel were inside or outside, for that matter—that does not make any difference—the minute there is a loose panel like that in a girdle, it can walk up.

"The Court: And that would happen if you had the panel inside or outside?

"The Witness: Or outside, it would not make any difference.

"The Court: And that is the reason you went to 301, you put the crotchpiece attached to the—

"The Witness: To the inside part.

"The Court: To the girdle part, right?

"The Witness: That is correct."



Thus, if garters are used with an Olga patent No. 3,142,301 (PX 1) brief having its panel underlying the girdle portion thereof, it would be a satisfactory garment. That is precisely the disclosure of the Rosenthal patent (PX 5).

Later at the trial, during examination by defendant's counsel, the patentee Olga Erteszek of defendant's patent No. 3,142,301 conveniently professed to have misunderstood the questions asked by the Court and by plaintiff's counsel above quoted. She testified (App. 357a):

"Q. Mrs. Erteszek, I believe while being cross examined by Mr. Taylor, you testified that you had made garments similar to Exhibit 19. Do you recall testifying to that effect? A. Yes, I do. I was mixed up. I misunderstood this question.

"Q. Are you sure that you at no time contemplated manufacture of a garment like Exhibit 19? A. I'm positive. It wouldn't make any sense."

Exhibit 19 garment is like garment PX 15 admittedly disclosed in Olga patent No. 3,142,301 (PX 1), but made with the front panel on the inside.

The Examiner following his initial examination in rejecting Olga application main claim 1 also held that the disclosure of the Rosenthal patent (PX 5) included leg openings defined by the free edges of the panel and crotch portion with the bottom edge of the girdle portion saying (PX 2, p. 10, App. E16):

"The patent to Rosenthal discloses an undergarment including a torso encircling body [girdle portion] made of elastic fabric, a front panel (7) having side edges sewn to the body portion [girdle] said side edges of the panel being free at the lower portion thereof, the free edges of the panel and crotch portion together with the bottom edge of the body [girdle] defining leg openings."

Following the rejection of original main claim 1 by the Examiner, it was amended on behalf of the applicant Olga to add following the last recited element (PX 2, App. E17):

“\* \* \* said panel in the worn condition of the garment elastically imposing stomach flattening force upon the underlying body [girdle] of the garment.”

Notwithstanding the above amendment of claim 1, the Examiner again rejected all six claims of the Olga application (PX 2) on the Rosenthal patent (PX 5) (App. E67). The applicant Olga failed to call the Maidenform Rosenthal garment advertisement of 1955 to the Examiner's attention. It emphasized (PX 14A, App. E93):

“The front's panelled for ‘tummy control’.”

Despite plaintiff's continued requests for production of the sample garments alleged to have been exhibited to the Examiner, which were not left in the Olga application file in the Patent Office, defendant failed to produce a sample Olga garment of the Olga patent No. 3,142,301 (PX 1), thus requiring plaintiff to make up one (PX 15). Indeed the patentee Olga admitted (App. 281a):

“I'm not aware that it was available to the trade.”

The Court then inquired (App. 283a-284a):

“Whether 301 was actually put on the market.”

Thereupon the patentee Olga testified (App. 283a):

“Q. Was the 301 patent, Plaintiff's Exhibit 1 garment here as Plaintiff's Exhibit 15, was that put on the market? A. Now, Mr. Taylor, this is something that I really don't have very much of a recollection  
\* \* \*

“The Court: If you don't know, is there someone from the business who is here. \* \* \*

“The Witness: I know if it was, it was a very short time, because I always tend to improve the existing garment.

“Q. In other words, the garment was unsatisfactory, in your opinion; is that correct? A. In my opinion, but then I am somewhat of an idealist.”

Turning now to the patent claims 1 and 2 of Olga patent No. 3,142,301 (PX 1) in respect of which a holding of invalidity is here sought by plaintiff, consideration will be directed first to main claim 1, since claim 2 is a claim dependent on claim 1. As the District Court remarked (App. 105a-106a):

“Claim 2 really is a little different kind of description, isn't it, of claim 1. It is describing the same physical design.

“Mr. White: Yes, no doubt.

“The Court: So we are really concerned with the description in claim 1 and, of course, the physical design.

“Mr. White: That's correct.”

Claim 1 of Olga patent No. 3,142,301 (PX 1) in analyzed form for convenience is as follows (App. E2):

1. An elasticized “brief” undergarment comprising
  - (a) a torso encircling body
    - (1) made of elastic fabric,
  - (b) a wide upper panel
    - (1) of elastic material
    - (2) overlying a substantial portion of the front of said body and
    - (3) having side edges sewn to said body along extents running from the body waist downwardly to locations spaced above the front bottom edge of the body,

- (c) said panel having lower side edge continuations of said upper edges which extend freely of attachment to the body below said locations, and
- (d) a crotch portion
  - (a) connected to one end to the bottom of said panel and
  - (2) at the other end to the bottom part of the rear of said body,
- (e) the panel being progressively narrowed downwardly between said lower edges to meet said crotch portion of the garment,
- (f) the lower free edges of the panel and the crotch portion together with a bottom edge of the body defining leg openings the edges of which are adapted to elastically fit the wearer,
- (g) said panel in the worn condition of the garment elastically imposing abdominal flattening force upon the underlying body of the garment.

The introductory clause of Olga claim 1, namely, "An elasticized 'brief' undergarment" limits the claim to a brief. The patentee Olga Erteszek testified (App. 254a-255a):

"Q. And would you tell me just rather briefly in general characterization the nature of the garment which is the subject matter of the patent, Plaintiff's Exhibit 1? A. This is what is called in the industry a brief. A brief is a panty girdle without legs. In other words, a body encircling garment with a crotch so that it would function with or without garters.

"Q. And will you tell me how long has the industry known a garment as you have designated it, a brief? A. A brief per se has been in the industry for many years."



The prior patent to Rosenthal (PX 5, App. E67) entitled "Girdle Panty Garter Belt" discloses (Figs. 1-3) a panty girdle without legs and having a body encircling portion (12) with a crotch (22) so that it can function with or without garters. The Maidenform advertisement (PX 14A, App. E93) of the Rosenthal garment shows the garment with garters which may be detached.

The patentee Olga Erteszek also testified (App. 256a):

"Q. Are you familiar with garments long prior or prior, at least, to, let us say, 1961 or 1960 in which the panty birdle or brief consisted of a girdle portion, a crotch portion and a panel portion connected to the crotch? A. Yes, there were garments differently designed but generally described in that way."

Element (a) of claim 1 recites "a torso encircling body made of elastic fabric". The patentee Erteszek explained (App. 255a):

"Girdle in our vernacular means a body encircling piece of fabric, be it elasticized or otherwise."

In Olga patent No. 3,142,301 (PX 1) the portion of the garment therein illustrated by numerals 15 to 13 is the girdle part (App. 255a).

The prior Rosenthal patent (PX 5) discloses and describes a torso encircling body or girdle (col. 1, lns. 29-33):

"The girdle 3 [Fig. 1] is constructed primarily, or as a whole of elastic material."

Element (b) of claim 1, recites "wide upper panel of elastic material overlying a substantial portion of the front of said body and having side edges sewn to said body along extents running from the body waist downwardly to locations spaced above the front bottom edge of the body".

The prior Rosenthal patent (PX 5) disclosure in respect of the relation of its panel and its torso encircling body or girdle portion was succinctly stated by the Examiner in the Patent Office as follows (PX 2, p. 10, App. E16):

"The patent to Rosenthal discloses an undergarment including a torso encircling body made of elastic fabric, a front panel (7) having side edges sewn to the body portion, said side edges of the panel being free at the lower portion thereof, the free edges of the panel and crotch portion together with the bottom edge of the body defining leg openings. The inclusion of a panel member disposed on the girdle body does not impose a limitation on the claims. Such an expedient is considered to be within the normal skills of the art, as are other dimensional differences that may exist between applicant's panel construction and that of Rosenthal."

And again the Examiner held (PX 2, p. 17, App. E23-E24):

"The inclusion of 'a front panel \* \* \* overlying the front of the body [girdle]' involves merely a simple expedient of choice. This would be an obvious reversal of arrangements. No new nor obvious result of advantage is seen in disposing the front panel upon the front body portion [girdle]."

Referring again to element (b) of claim 1 of Olga patent No. 3,142,301 (PX 1), in the Rosenthal patent Fig. 1 (PX 5), the side edges of the panel 7 are sewn along seams 8 to the girdle portion 3. The side edges sewn to the girdle 3, are sewn along extents or seams 8, from the waist 9, of the girdle 3, to locations spaced above the front bottom edge of the girdle 3.

The patentee Olga Erteszek represented to the Patent Office (PX 2, p. 20, App. E26-E27):

"As the Examiner has indicated in the Official Action of December 10, 1963, one of the principal differences

between the applicant's garment and that disclosed in Rosenthal lies in the fact that the appellant's 'panel' overlies or is on the outside of the torso encircling body [girdle]."<sup>2</sup>

In view of the testimony *supra* pages 9-10, of patentee Olga Erteszek concerning the construction by her of a garment like that of Olga patent No. 3,142,301 (PX 1) but with the panel on the inside like Rosenthal (PX 5) the decision of the District Court in *Warner Bros. v. American Lady Corset*, 48 F. Supp. 417 (aff. 2 Cir., 136 F.2d 93) is pertinent. There the Court said (p. 421):

"With these various garments in the prior art, Field it seems to me did a simple thing, I use the term simple in the sense of being obvious; he shifted panels of material old in the art, around. To accomplish this was but this exercise of the mechanical skill to be expected of any skilled corset designer with the prior art before him. It was an obvious step to rearrange panels to accomplish the result he desired. \* \* \* The most that one can say is that Field added something to the prior art which made it a bit more useful, but that is not invention."

Element (c) of claim 1, recites "said panel having lower side edge continuations of said upper edges which extend freely of attachment to the body below said locations".

Figure 1 of the Rosenthal patent (PX 5) clearly illustrates that the edges of the panel 7 extend freely of attachment to the body 3, the girdle portion, below the points of attachment to the seams 8. The Examiner in the Patent Office held (PX 2, p. 10, App. E16):

"The patent to Rosenthal discloses an undergarment including a torso encircling body made of elastic fabric, a front panel (7) having side edges sewn to the body portion, said side edges of the panel being free at the lower portion thereof \* \* \*."

Element (d) of claim 1, recites "a crotch portion connected at one end to the bottom of said panel and at the other end to the bottom part of the rear of said body".

Figure 3 of the Rosenthal patent (PX 5) illustrates the crotch portion 5 thereof of soft fabric, connected at one end through an elastic member 10, to the bottom of the panel 7 and at the other end to the bottom part of the rear of the girdle member body 3.

Element (e) of claim 1, recites "the panel being progressively narrowed downwardly between said lower edges to meet said crotch portion of the garment".

Figure 1 of the Rosenthal patent (PX 5) illustrates the reverse in that the crotch portion 5 is progressively widened to join with the front panel 7, through the interposed elastic member 10.

The Examiner in the Patent Office held that (PX 2, p. 10, App. E16)) "dimensional differences that may exist between applicant's [Olga] panel construction and that of Rosenthal" is considered "to be within the normal skills of the art".

Element (f) of claim 1, recites "the lower free edges of the panel and the crotch portion together with a bottom edge of the body [girdle] defining leg openings the edges of which are adapted to elastically fit the wearer".

The Examiner in the Patent Office held that the patent to Rosenthal (PX 5) discloses (PX 2, p. 10, App. E16):

"\* \* \* the free edges of the panel and crotch portion together with the bottom edges of the body [girdle] defining leg openings."

The leg openings of the "curved and gathered" leg receiving portions 4" (PX 5, col. 1, ln. 35, App. E68) of the garment illustrated and described in the Rosenthal patent (PX 5) are adapted to elastically fit the wearer since they are "curved and gathered".



The District Court in *Gossard v. Neatform*, 143 F. Supp. 139 (aff. 2 Cir., 240 F.2d 948) in holding patent No. Des. 174,054 (PX 7) invalid said (p. 141):

"It was also admitted that an elastic edging or decoration around the perimeter of each leg opening is not new."

Element (g) of claim 1, recites "said panel in the worn condition of the garment imposing abdominal flattening force upon the underlying body of the garment."

But the description of the garment of earlier Olga patent No. 3,142,301 (PX 1) as given in the later Olga patent No. 3,142,300 (PX 3) is as follows (PX 3, col. 1, lns. 43-47, App. E35):

"The panel structure serves the further important function of reinforcing the front area of the girdle for stomach confinement, an effect which is enhanced by the crotch section in the worn condition of the garment to tension downwardly the panel area."

It was represented by Olga in the Patent Office in respect of the Rosenthal patent (PX 5) (PX 2, p. 12, App. E18):

"Should the crotch piece be tensioned, apparently the only effect it could have on the outside body would be to exert some tension along the seam lines 8."

Likewise, in the Olga patent No. 3,142,301 (PX 1) should the crotch piece 22 be tensioned it would exert some tension along the seam lines 17.

#### **1. The Statute 35 U.S.C. 103 And The Applicable Decisions Thereunder.**

In *Graham v. John Deere Co.*, 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545 (Feb. 22, 1966), the Supreme Court re-defined the three conditions of patentability, each of which

must be satisfied if a patent is to be found valid. The article covered by the claims must be (1) useful, (2) novel, and (3) non-obvious. The requirements of utility and novelty are expressed in 35 U.S.C. §§ 101 and 102. The requirement of non-obviousness is expressed in 35 U.S.C. § 103, enacted in 1952, which provides:

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. \* \* \*

*Graham* held that Section 103 is merely a codification of the rule laid down by a line of judicial decisions beginning over a century ago with *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248, 13 L.Ed. 683 (1850). As to this section, the Court in *Graham* said:

"Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the subject matter of obviousness or nonobviousness, these inquiries may have relevancy." (383 U.S. at 17-18, 86 S.Ct. at 694)

The most recent case involving a combination patent for a garment was decided by this Court in 1966. In *Formal Fashions v. Braiman Bows*, 369 F.2d 536, this Court affirmed the District Court, 254 F. Supp. 389. The patent

for "Body Encircling Garments" was held to be invalid as obvious under 35 U.S.C. 103.

Claim 1 of the patent in *Formal Fashions*, *supra*, related to a cummerbund, the others to a body encircling garment (p. 389).

Six prior patents were relied upon as constituting prior art (p. 393), and all of the prior art patents except one related to neckties. One related to a "combined suspenders and belt" (p. 393). The District Court said (p. 393):

"None of the articles covered by these patents looks like plaintiff's universal size cummerbund. *But one or another of them discloses each of the separate elements with one possible exception, that goes into the cummerbund.* These patents involve garments which encircle the body." (Emphasis added.)

Here, the most pertinent prior art patent with respect to Olga patent No. 3,142,301 (PX 1) is that of Rosenthal (PX 5) which is for a "Girdle Panty Garter Belt". It provides "a single garment which will have the operating effect on the wearer of a girdle, a panty, and a garter belt" (PX 5, col. 1, lns. 15-17, App. E68).

The District Court in *Formal Fashions* remarked (p. 393):

"Plaintiff's do not assert that any separate element of their article is novel. They claim novelty for the combination of these old elements, a combination never previously disclosed, which accomplishes a new and useful purpose."

And held (p. 394):

"Subsequent to the enactment of Section 103, a number of decisions have applied the rule of that section to combination patents and have held that, although the combination was novel, it was obvious, and hence

that the patent was invalid. See, for example: *Welsh Mfg. Co. v. Sunware Products Co.*, 236 F.2d 225 (2d. Cir. 1956); *Bussemer v. Artwire Creations, Inc.*, 23 F. Supp. 798 (S.D.N.Y. 1964); *Modella Mfg. Co. v. Famous Bathrobe Co.*, 151 F. Supp. 542 (S.D.N.Y. 1956), *affd.* on opinion below, 244 F.2d 954 (2 Cir. 1957)."

Defendant's Proposed Findings and Conclusions numbered 5 and 6 (p. 3) submitted in the District Court quote descriptions contained in the specification of Olga patent No. 3,142,301 (PX 1) and in proposed Finding 6 emphasized the novelty of the *combination* of the old elements stating (No. 6, p. 3):

"The 3,142,301 patent teaches attainment of this object

- (a) by utilization of 'a simple construction and *combination* of a torso-encircling elastic body portion which serves the purposes of a girle, and a front panel and crotch portion so associated therewith as to form, with independent capaticites for movement \* \* \* an overlying front reinforcement and means in conjunction with the body [portion] providing the leg opening'." (Emphasis added.)

In the case entitled *Modella Mfg. Co. v. Famous Bathrobe Co.*, decided by this Court (244 F.2d 954, 1957) affirming the District Court 151 F. Supp. 542, and cited in the *Formal Fashions* decision, it was held by the District Court (p. 543):

"\* \* \* In order to gain the monopoly secured by the patent statutes (35 U.S.C.A. § 100 et seq.) more than an aggregation of old elements producing no new function must be shown and more ingenuity must be present than would be expected from an ordinary



mechanic skilled in the art. *Hotchkiss v. Greenwood*, 11 How. 248, 52 U.S. 248, 13 L.Ed. 683; *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U.S. 84, 62 S.Ct. 37, 86 L.Ed. 58; *Great A & P Tea Co. v. Supermarket Equipment Corporation*, 340 U.S. 147, 71 S.Ct. 127, 95 L.Ed. 162.

"In the patent under consideration, *all of the elements are old; all of the results of the aggregation of the elements are predictable*; and no ingenuity is shown exceeding that to be expected from the ordinary mechanic skilled in the art. Mere commercial success cannot be a substitute for the absence of patentable novelty. *Rolscreen Co. v. Abraham & Strauss, Inc.*, 2 Cir., 105 F.2d 962." (Emphasis added.)

The Court of Appeals for the Seventh Circuit in *Gossard v. J. C. Penney Co.*, 304 F.2d 515, held patent No. 2,802,822 for "Foundation Garment" invalid, saying (p. 518):

"The District Court also has found that *each of the individual components of the claimed invention was well known in the prior art*, and that the patentee has not produced any unusual or surprising consequences from the unification of the old elements or components of the prior art." (Emphasis added.)

The garment of the patent in the *Penney* case not unlike the garment of Olga patent No. 3,142,301 (PX 1) in the instant case was said (p. 516):

"\* \* \* to lift the abdomen and control the hips and thighs and the overlapping portions of the bands, being stitched together and thus being non-stretchable where overlapped in the region of the abdomen, exert an additional flattening effect on the uplifted abdomen."

In holding the patent in the *Penney* case invalid, the Court of Appeals said (p. 517):

"The patentee utilized the common teachings of the prior art, but she did relocate to some extent, the various arrow shaped bands. In doing so, patentee did nothing that could not have been accomplished by the ordinary person skilled in the art. What patentee did undoubtedly required some skill, but what she did cannot be said to rise to the dignity of an invention." (Emphasis added)

The Court in the *Penney* case referred to the decision of this Court in *Warner Bros. v. American Lady Corset Co.*, 136 F.2d 93, saying (p. 517):

"Another pertinent decision was by the Second Circuit in *Warner Bros. Company v. American Lady Corset Company*, 2 Cir., 136 F.2d 93. This involved the well known patent to Field, No. 1,995,801 granted March 26, 1935. This patent was for the first 'two-way stretch girdle' ever placed on the market and had a very wide acceptance. After some years, the patent was challenged. The patent was for a garment consisting of panels of elastic fabric, some panels stretching one way and others another. The advantage claimed was confining and flattening at various portions of the garment, somewhat similar to the claims of the patent in suit. The entire garment was described as constituted of various panels having different degrees and directions of stretch. The Court held that the patent was invalid as requiring no more than the skill of the calling."

The District Court in the *American Lady* case affirmed by this Court held specifically (p. 422) that the shifting of panels old in the art in a garment to effect control over the abdomen involved the exercise of that mechanical skill to

be expected of any skilled corset designer with the prior art before him.

It is submitted that the evidence adduced herein considered in the light of the above quoted pertinent decisions shows that the subject matter of the combination claims 1 and 2 of Olga patent No. 3,142,301 (PX 1) are invalid under 35 U.S.C. 103, as obvious.

## **2. The Elasticized Panty Girdle Garment Of Olga Patent No. 3,142,300.**

The later filed April 29, 1963, Olga alleged improvement patent No. 3,142,300 (PX 3, App. E34) states that it (col. 1, lns. 8-14, App. E35):

“\* \* \* relates to elasticized panties in the category of so-called ‘briefs’ in that the garment is legless and is adapted to elastically fit about the wearer’s legs.”

The above quoted same description was made in earlier filed November 20, 1962, Olga patent No. 3,142,301 (PX 1).

Olga patent No. 3,142,300 (PX 3) then states (col. 1, lns. 11-14, App. E35):

“The present application is directed to improvements in the type of structure dealt with in my copending application [PX 2, now patent 3,142,301, PX 1] \* \* \* on Elasticized Panty Garment.”

Thereupon a description of the disclosure of Olga patent No. 3,142,301 (PX 1) is given.

The object of the Olga patent No. 3,142,300 (PX 3) is stated as follows (col. 1, lns. 48-63, App. E35):

“The primary object of the present invention is to provide a garment characterized as in the foregoing, wherein the elasticized body and front panel portions have freedom for relative movements and conform-

ances, but wherein I have incorporated an interconnection which supplements the stomach flattening effect of the front area of the body of the garment. As will appear, this result is achieved by attachment of a crotch piece, preferably of non-elastic material and freely flexible fabric, to the bottom of the body front and to the crotch area defined by downward extension of the overlying front panel. The resulting effect, in the worn condition of the garment, is to transmit tension from the front panel crotch extent to the bottom of the underlying body, in a manner imparting to the latter the capacity for generally vertical, as well as horizontal, confinement of the stomach." (Emphasis added)

Drawings were submitted with the application to illustrate the construction of the garment in which Fig. 1 thereof is identical in both Olga patent No. 3,142,301 (PX 1) and in Olga patent No. 3,142,300 (PX 3).

The detailed description of the construction of the garment given in the later filed Olga patent No. 3,142,300 (PX 3) is substantially that given of the garment in earlier Olga patent No. 3,142,301 (PX 1) (compare PX 1, col. 1, lns. 58-72, col. 2, lns. 1-40, App. E2, with PX 3, col. 2, lns. 1-47, App. E35).

### **3. The History Of The Application For Olga Patent No. 3,142,300 In The Patent Office.**

The Olga application (PX 4) for patent No. 3,142,300 (PX 3) filed April 1963 (App. E38) was submitted with five claims, a main claim 1 and four dependent claims, each dependent claim reciting the several elements of main claim 1, with additional elements (see PX 4, pp. 7-8, App. E45-A46).



Main claim 1 in analyzed form for convenience recited (PX 4, p. 7, App. E45):

1. An elasticized panty undergarment comprising
  - (a) a torso encircling body
    - (1) made of elastic fabric,
  - (b) a front panel
    - (1) of elastic material
    - (2) overlying and
    - (3) having side edges sewn to said body waist downwardly to locations below,
  - (c) the front bottom extent of said body beneath said panel
    - (1) having freedom for movement relative thereto,
  - (d) said side edges of the panel being free below said locations and
  - (e) the panel being progressively narrowed downwardly to a crotch portion of the garment connected to the rear of the body,
  - (f) the free edges of the panel and crotch portion
    - (1) together with the bottom edge of the body
    - (2) defining leg openings the edges of which are adapted to elastically fit the wearer, and
  - (g) a flexible crotch piece attached to the front central bottom of the body
    - (1) beneath said panel and
    - (2) attached to the inside of the narrowed portion of the panel.

Before the Examiner in the Patent Office had an opportunity to act on the Olga application (PX 4) an amend-

ment to claim 1 was submitted which added a phrase to the last line of claim 1 as filed, namely (PX 4, p. 11, App. E49).

“said panel in the worn condition of the garment elastically imposing stomach flattening force upon the underlying body of the garment.”

In addition to submitting the above amendment to claim 1, the same remarks submitted August 27, 1963, in Olga patent No. 3,142,301 (PX 1) application (PX 2) were submitted. Those remarks were made originally following the rejection by the Examiner of the Olga patent No. 3,142,301 (PX 1) application (PX 2) on the Rosenthal patent (PX 5).

Despite the submission of the remarks and the addition of the phrase to the last line of the claim, the Examiner rejected main claim 1 and the four dependent claims holding (PX 4, p. 15, App. E53).

“Claims 1-5 are rejected as indefinite, incomplete, and uncorrelated with respect to the pertinent positional cooperative relationship of the front panel with the torso-encircling element and the crotch portion to provide an operative device and thus effect the intended functions. The inclusion of, ‘edges running from the body waist downwardly to locations below’ is meaningless. Further, ‘the front bottom extent’ lacks antecedental structure. Also, the recitation of ‘side edges of the panel being free below said location’, does not impose a limitation on the claims since ‘said locations’ have not been oriented on the garment.”

In response to the Examiner's rejection, all five claims were cancelled and a main claim 6, now Olga patent No. 3,142,300 (PX 3) main claim 1, and two dependent claims were submitted, now claims 2 and 3 of the Olga patent No. 3,142,300 (PX 3).

With the submission of the new claims, it was represented (PX 4, pp. 18-19, App. E56):

"The original claims are cancelled without intended acquiescence in any close pertinency of the cited art, but instead to substitute new claims 6 to 8 which are believed more clearly to define the invention and its distinctions over the references.

"New claim 6 corresponds to allowed claim 7 in copending application Serial No. 238,854, *with further limitation as to the flexible crotch piece 24 which distinguishes the present invention from the prior disclosure.*

"Concerning the claim, it will be noted that the panel is stated to have lower side edge continuations which progressively narrow downwardly to the crotch, the lower free edges of the panel and crotch portion, together with a bottom edge of the body, defining leg openings. *The claim further specifies a flexible crotch piece attached to a front central bottom edge portion of the elastic fabric body which extends across and beneath the downwardly narrowed portion of the panel.*" (Emphasis added.)

It is to be noted that reliance was made on the fact that the new claim 6, thereafter to be renumbered 1 in Olga patent No. 3,142,300 (PX 3), corresponded to already allowed claim 7 in Olga application (PX 2), thereafter to be renumbered 1 in Olga patent No. 3,142,301 (PX 1).

Claim 6 of the Olga patent No. 3,142,300 application (PX 4) now claim 1 of the said patent reads as follows in analyzed form for convenience (App. E55-E56).

1. An elasticized "brief" undergarment comprising
  - (a) a torso encircling body
    - (1) made of elastic fabric,

- (b) a wide upper panel
  - (1) of elastic material
  - (2) overlying a substantial portion of the front of said body and
  - (3) having side edges sewn to said body along extents running from the body waist downwardly to locations spaced above the front bottom edge of the body,
- (c) said panel having lower side edge continuations of said upper edges which extend freely of attachment to the body below said locations, and
- (d) a crotch portion
  - (1) connected at one end of the bottom of said panel and
  - (2) at the other end to the bottom part of the rear of said body,
- (e) the panel being progressively narrowed downwardly between said lower edges to meet said crotch portion of the garment,
- (f) the lower free edges of the panel and the crotch portion together with a bottom edge of the body defining leg openings the edges of which are adapted to elastically fit the wearer,
- (g) said panel in the worn condition of the garment elastically imposing abdominal flattening force upon the underlying body of the garment, and
- (h) a flexible crotch piece
  - (1) attached to a front central bottom edge portion of the elastic body
  - (2) extending across and beneath said downwardly narrowed portion of the panel,



- (i) said crotch piece also being attached to the inside of the narrowed portion of the panel below the crotch piece attachment to the body.

Comparison of Olga patent No. 3,142,300 (PX 3) claim 1, *supra*, pages 29-31, with claim 1 of Olga patent No. 3,142,301 (PX 1) reproduced hereinabove at pages 13-14 shows that the introductory phrase and the elements recited (a)-(g), inclusive are identical in each claim.

The elements recited in Olga patent No. 3,142,300 (PX 3) claim 1 in addition to those recited in Olga patent No. 3,142,301 (PX 1) claim 1 are those designated (h) and (i). The elements (h) and (i) prescribe "a flexible crotch piece".

Prior art patent to Olga Erteszek No. 2,660,173 (PX 11, App. E83) was exhibited to Olga Erteszek. She identified the patent as one granted to her (App. 308a). The patent (PX 11) discloses a flexible crotch insert, "flexible in this particular case means elasticized so that it stretches" (App. 309a).

Olga patent No. 2,660,173 (PX 11) states (col. 2, lns. 15-21, App. E84):

"First it should be understood that the invention is applicable to any of various pantie girdle constructions, and that the type and form shown in Fig. 1 is to be regarded merely as illustrative of various particular forms to which the invention is adaptable."

And it describes the construction of the garment thereof (col. 2, lns. 27-33, App. E84):

"\* \* \* The front of the garment and also the rear if desired, may contain any suitable insert, such as the diamond shaped panel 11, having little or no horizontal elasticity, but which is elastic vertically of the girdle. At the bottom, the garment contains the usual leg openings at 12 at opposite sides of the elastic crotch piece 13."

The crotch piece insert is described as follows (col. 2, lns. 40-44, App. E84) :

“\* \* \* The insert 15 is shown to have the form of an elongated material proportioned to overlie the body material of the girdle at the inside of the crotch opening 14, and beyond its sides and ends.”

Olga patents No. 3,142,300 (PX 3) and No. 3,142,301 (PX 1) issued on the same day, namely, July 28, 1964. Patent No. 3,142,301 (PX 1) was filed November 20, 1962 and patent No. 3,142,300 (PX 3) was filed April 29, 1963. Thus, No. 3,142,301 (PX 1) the senior patent and the subject matter thereof is prior art in respect of patent No. 3,142,300 (PX 3), despite the fact that both patents issued to the same person, Olga Erteszek, on the same day.

Olga patent No. 3,142,301 (PX 1) being the senior patent and the subject matter of claim 1 of junior Olga patent No. 3,142,300 (PX 3) being substantially identical with that of claim 1 of Olga patent No. 3,142,301 (PX 1), it is invalid under 35 U.S.C. 103. The addition of a flexible crotch piece to the old combination of claim 1 of Olga patent No. 3,142,301 (PX 1) was obviously within the skill expected from an ordinary dressmaker skilled in the art with patent No. 2,660,173 (PX 11) before her.

The Court in *Harvey Hubbell, Inc. v. General Electric Co.*, 267 F. 564, held (p. 568) :

“Although the patents in suit issued on the same day to the same man, the senior patent is prior art. By rebuttable presumption the earlier in number of several patents dated alike is earlier in publication (*Crown Cork, etc., Co. v. Standard, etc., Co.*, 136 Fed. 841, 69 C.C.A. 200) ; but in this case application was made for the junior patent more than a year after that for the senior had been filed, and the former is confessedly for an improvement on the latter. Under

such circumstances the art to and including the senior patent is known to the patentee, not only by legal presumption, but by personal study. *Writing Machine Co. v. Elliott, etc., Co.* (C.C.) 106 Fed. 507; *Willcox, etc., Co. v. Merrow, etc., Co.*, 93 Fed. 206, 35 C.C.A. 269."

In the *Kirsch Mfg. Co. v. Gould Mersereau Co.*, 6 F.2d 793, this Court held Kirsch's later patent invalid as unpatentable over his earlier patent. And, in *Cutler-Hammer Mfg. Co. v. Beaver Machine Tool Co., Inc.*, 5 F.2d 357, this Court declared (p. 460):

"The essentials of the construction covered by the claims of this patent were known to the inventor, as indicated by his prior inventions, for which he has obtained patents; \* \* \*. We think there was no invention over what was disclosed in the prior art."

In *Hazeltine Corporation v. Radio Corporation of America*, 52 F.2d 504, citing the cases referred to above, this Court said (p. 511):

"Plate neutralization is as much in the prior art by reason of Hazeltine's own earlier patent therefor as if it were the creation of some one else. *Underwood v. Gerber*, 149 U.S. 224, 227, 231, 13 S.Ct. 854, 37 L.Ed. 710; *Kirsch Mfg. Co. v. Gould Mersereau Co.* (C.C.A. 2) 6 F.(2d) 793, 794; *Cutler Hammer Mfg. Co. v. Beaver Machine & Tool Co., Inc.* (C.C.A. 2) 5 F.(2d) 457, 460; *Harvey Hubbell, Inc. v. General Electric Co.* (C.C.A. 2) 267 F. 564, 568; *Doig v. Morgan Machine Co.* (C.C.A. 2) 122 F. 460, 462. And cf. *National Electric Ticket Register Co. v. Automatic Ticket Register Corporation* (C.C.A. 2) 15 F.(2d) 257, 250."

#### 4. The Issue Of Infringement.

Plaintiff's Counsel, Willis H. Taylor, Jr., was asked by letter dated August 22, 1966, from the Secretary of Vanity

Fair Mills Inc., Mr. F. Eaton, Jr., to give his opinion as to the validity of U.S. Patents Nos. 3,142,300 (PX 3) and 3,142,301 (PX 1) of Olga Company and also as to infringement thereof by Vanity Fair proposed garment style 40-28 (PX 23), which had not then been put on the market.

Counsel submitted a letter opinion dated October 5, 1966, which advised:

"Over the years, very few patents relating to garments have been held to be valid by the Courts. It seems reasonable to expect that garment patents will continue to be difficult to sustain in view of the recent decisions of the Supreme Court in mechanical case (see *Graham v. John Deere & Co.*, 383 U.S. 1, 1966). Since the 'girdle' and the 'panty girdle' arts are old and well developed, there is little room for non-obvious developments.

"While your company might be sued for infringement of subject patents (3,142,300-301) should you decide to market the present design for Vanity Fair panty girdle brief (enclosed) it would appear that the prior art patents are sufficiently close to indicate that the patents would be held to be invalid."

In *Formal Fashions, Inc. v. Braimin Bows*, 254 F. Supp. 389, 1966 (aff. 369 F.2d 536, 1966), the District Court said (p. 391):

"I have no doubt that Oscar Goldenberg and defendant have knowingly capitalized upon plaintiff's idea. They have done so in reliance on their belief that they could successfully defend any suit for infringement that plaintiff might bring. Plaintiff has now brought that suit, thereby putting defendant's opinion to the test. I am called upon to decide the two questions of law which it involves: (1) is plain-



tiff's patent valid; (2) if so, has defendant infringed it?"

This Court in *Formal Fashions v. Braiman Bows*, 369 F.2d 536, affirming the District Court, 254 F. Supp. 389, held patent No. 2,914,070 for "Body Encircling Garments" invalid under Section 103. The District Court said (p. 395):

"Since plaintiff's patent is invalid it is clear that plaintiff cannot maintain an action for its infringement. It is thus unnecessary to consider whether defendant's garment infringes. Nor is there any occasion to render a declaratory judgment on defendant's counterclaim as to this aspect of the case."

In *Modella v. Famous Bathrobe*, 151 F. Supp. 542 (aff. 244 F.2d 954, 2 Cir.) the District Court having held the patent invalid said (p. 544):

"The patent being invalid, it cannot be infringed."

*Walker On Patents-Deller's Edition*, states (p. 1682):

"A patent must be a 'valid' one in order to support a charge of infringement thereof. *Marsh v. Nichols*, 128 U.S. 605."

It is submitted that defendant cannot maintain its action for infringement of defendant's Olga patents Nos. 3,142,300 (PX 3) and 3,142,301 (PX 1) and that its action should be dismissed.

Plaintiff discontinued in 1969 the manufacture and sale of its panty brief style 40-28 (PX 23) charged to infringe both defendant's Olga patents.

#### IV. CONCLUSION

**It is submitted that defendant-appellee's Olga patents should be held invalid as obvious under 35 U.S.C. 103, and that being invalid cannot be infringed, and, further, that defendant's counterclaim should be dismissed, reversing the District Court.**

Respectfully submitted,

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UNITED STATES COURT OF APPEALS  
FOR THE SECOND CIRCUIT

VANITY FAIR MILLS INC.,

Plaintiff-Appellant,

-against-

OLGA COMPANY (INC.),

Defendant-Appellee.

State of New York,  
County of New York,  
City of New York—ss.:

David F. Wilson being duly sworn, deposes  
and says that he is over the age of 18 years. That on the 2nd  
day of July, 1974, he served two copies of the  
Plaintiff-Appellant's Brief on Stuart White, Esq. on  
the attorney for the Defendant-Appellee  
by depositing the same, properly enclosed in a securely sealed  
post-paid wrapper, in a Branch Post Office regularly maintained  
by the Government of the United States at 90 Church Street, Borough  
of Manhattan, City of New York, directed to said attorney at  
No. Island Falls, Maine 04747 ( ) ~~XXXX~~  
that being the address designated by him for that purpose upon  
the preceding papers in this action.

*David F. Wilson*

Sworn to before me this

2nd day of July, 1974.

*Courtney J. Brown*

COURTNEY J. BROWN  
Notary Public, State of New York  
No. 31-547,920  
Qualified in New York County  
Commission Expires March 30, 1976

Due and timely service of Two copies  
of the within BRIEF is hereby  
admitted this 2<sup>ND</sup> day of JULY 1974

*Michael D. Gork*  
.....  
Attorney for APPELLER



